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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,509	04/19/2004	Mark V. Holzmann	4191-00347	3482

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EXAMINER
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BUSHEY, CHARLES S

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/827,509

Applicant(s)

HOLZMANN ET AL.

Examiner

Scott Bushey

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) 12-31, 38, 41 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 32-37, 39, 40 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-6-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-42, and 46-48, and Species K of the invention, as depicted by Fig. 13 in the reply filed on May 30, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

In accordance with the election, claims 1-11, 32-37, 39, 40, and 46-48 have been examined on the merits herein, while claims 12-31, 38, 41 and 42 are withdrawn from further consideration.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

3. The disclosure is objected to because of the following informalities: page 2, line 26, "exists" should be replaced by --exits--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Witchell (Fig. 1; col. 2, lines 26-33).

6. Claims 1-7, 32-37, 39, 40, and 46-48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brown (Figs. 1-5; col. 1, lines 23-25, 50-52, 59-68; col. 2, lines 1-2).

Applicant should note that rigid portions (25,26,27) form the support frame of the filter element, while the resilient material that encases the rigid portions forms the seal member, the combination of which anticipates the instant claims.

7. Claims 1-7, 32-35, and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lanier, Jr. et al (Figs. 1,2,8, and 9).

8. Claims 1, 2, 8, and 32-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pomplun et al (Figs. 2-4; col. 3, lines 17-30, 64-67; col. 4, lines 1-11).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Witchell, Brown, Lanier, Jr. et al, and Pomplun et al, taken together with Ham.

Each of the alternative primary references have been applied above and each substantially disclose applicant's invention as recited by instant claim 9, except for the seal material being TPE.

Ham (Fig. 1; col. 2, lines 32-36; claim 15) discloses a filter element with an outwardly projecting flange element formed entirely from TPE, the flange element including a sealing portion. Wherein each of the alternative primary references disclose forming a seal element from a resilient material, such as an elastomer or thermoplastic material in general, it would have been obvious for an artisan at the time of the invention, to form the seal element of any one of the alternative primary references, from TPE, in view of Ham, since such is well known within the art to possess desirable elastomeric mechanical properties, while also allowing for convenient thermal reprocessing.

12. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Witchell, Brown, Lanier, Jr. et al, and Pomplun et al, taken together with Romenesko et al.

Each of the alternative primary references have been applied above and each substantially disclose applicant's invention as recited by instant claims 9-11, except for the seal material being TPE, TPV, or TPSiV.

Romenesko et al (col. 1, lines 22-30, 46-62; col. 3, lines 60-67; col. 4, lines 1-4, 24-28) disclose the well known advantages of forming an element wherein elastomeric mechanical properties are required, but which also allows for thermal reprocessing, resistance to solvents, and resistance to fire, such as would be desirable within a seal element of an automobile engine filter. In view of the teachings by Romenesko et al, it would have been obvious for an artisan at the time of the invention, to form the seal element of any one of the alternative primary references, from TPE, TPV, or TPSiV, since such is well known within the art to possess desirable elastomeric mechanical properties, while also allowing for convenient thermal reprocessing, and being resistant to solvents and fire.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Bushey whose telephone number is 571 272-1153. The examiner can normally be reached on M-Th 6:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Bushey  
Primary Examiner  
Art Unit 1724

csb  
6-21-06



6-21-06